Supreme Court, U.S.
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No. 99-1996

IN THE

Supreme Court of the United States

J.E.M. AG SUPPLY, INC. (doing business as Farm Advantage, Inc.) FARM ADVANTAGE, INC., LARRY BENZ, MERLE PRUETT (doing business as Siouxland Seeds, Inc.), KEVIN WOLFSWINKEL, TIM KAMSTRA and TOM EISCHEN SEED & CHEMICALS,

Petitioners,

v.

PIONEER HI-BRED INTERNATIONAL, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF

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STATEMENT PURSUANT TO RULE 29.6

None of the corporate petitioners has a parent company and no publicly held company owns 10% or more of the stock of any such petitioner.

Pioneer's Brief in Opposition at page 12 states: "... *Brown & Williamson* [529 U.S. __, 120 S. Ct. 1297 (2000)] ... is completely inapplicable to the present issue because of the express intent of § 101 to cover 'anything made under the sun by man.' " First, *Brown & Williamson* is directly on point because it examined the actual text of the statutes in question and applies the rule that a subsequent, more specific statute controls over a general statute that might otherwise cover the subject matter in question. Second, and more important, the "express intent of § 101" was set out in the actual text of the statute when Congress passed the 1952 Patent Act and moved "plants" to §§ 161-164 of Title 35. The phrase Pioneer bases its entire position upon, "anything made under the sun by man", is drawn from legislative history, not statutory text. Further, it is not even an accurate quote from the legislative history, and is given a meaning by Pioneer not intended by its author because Pioneer is using the phrase out of context. The correct statement in the legislative history is: "A person may have 'invented' a machine or manufacture which may include anything under the sun that is made by man ..." Sen. Rep. No. 82-1979, p. 5. The very next page of that report explains that the "plant patents" provisions have been omitted from § 101 and moved to Chapter 15. The 1952 Congress did not intend "anything under the sun that is made by man" to include "plants". The 1952 Congress intended that "plant patents" would be issued only under the provisions of Chapter 15 of Title 35, which restricted those patents to the right to exclude others from *asexually* reproducing the patented plant.

Pioneer at page 10 of its Brief in Opposition incorrectly recounts the statutory history of the 1930 Plant Patent Act and the 1952 Patent Act. Pioneer states at page 10:

> Congress, recognizing a gap, not in protection but in application (35 U.S.C. § 112), drafted the 1930

> Plant Patent Act. That act did not exclude anything from § 101, but instead created an entirely new form of protection which was set forth in section 161 of Title 35 for asexually reproduced plants. Again, § 101 remained substantially unchanged.

The above passage demonstrates a total misunderstanding of the successive statutes enacted by Congress. The 1930 Plant Patent Act (Revised Statutes, §§ 4884, 4886 and 4888) was an amendment to the statutory provisions that were the precursor of 35 U.S.C. § 101. It wasn't until the 1952 Patent Act that Congress drew 35 U.S.C. § 101 as it now substantially reads. The 1952 Congress deliberately chose not to include plant patents in § 101 and instead separated the plant patent provisions from the other provisions defining patentable subject matter. The 1952 Congress placed the plant patent provisions in Chapter 15 and placed the utility patent provisions in 35 U.S.C. § 101.

Pioneer states at pages 9-10 of its Brief in Opposition that the federal statutory protection provided by the Plant Variety Protection Act and the Plant Patent Act cover only "distinct and separate categories into which the vast majority of plants do not fall." This assertion is not true. Asexual reproduction of a plant occurs when the plant is reproduced in a manner other than by seed, and produces a genetic clone of the single parent plant. A plant that is reproduced by sexual reproduction (by seed) produces offspring with a genetic pattern different than that of the two parents — a range of genetic combinations. *Imazio Nursery, Inc. v. Dania Greenhouses*, 69 F.3d 1560, 1567-1568 (Fed. Cir. 1995), *cert. denied*, 518 U.S. 1018 (1996). The term "variety" in 35 U.S.C. § 161 (PPA) means a single plant. The PPA does

not grant protection to a range of plants, as the PVPA does. *Id.*, 69 F.3d at 1567. "Plants true-to-type, although different in a strict genetic sense, are protectable under the PVPA." *Id.* at 1567, n.7 (citing *Chakarbarty*). The commercial value of plants, or PVPA plant varieties, depends upon the ability to reproduce them, asexually or sexually, depending upon which is most suitable for the particular type of plant or plant variety. The PPA and the PVPA grant the right to exclude others from carrying on these essential commercial activities and thus cover the field of federal statutory protection for plants and plant varieties intended by Congress. The very seed purchased by Petitioners that is the basis of Pioneer's patent infringement action was produced in commercial quantities by sexual reproduction.

At page 2 of its Brief in Opposition, Pioneer quotes this statement from the district court's ruling upholding Pioneer's motion for summary judgment:

> History demonstrates, however, that in those instances where inventors showed they could define a reproducible plant meeting the limits of § 112, plant patents were issued under § 101. An early example of this is the Boehm patent, U.S. Patent 2,048,056 (1936) (Plaintiff's Exhibit D).

First, 35 U.S.C. § 101 had not yet been enacted when the Boehm patent was issued in 1936. The Boehm patent was issued under Revised Statutes, §§ 4884, 4886 and 4888, which included the 1930 Plant Patent Act. Second, the Boehm patent claims a method of plant grafting and "[t]he plant which is the product of the method of claim 1 . . ." Boehm patent, U.S. Patent 2,048,056 (1936) p.3. The patent did not claim a plant variety developed by sexual

reproduction, like the Pioneer corn plant varieties that are the subject of this case.

At page 5 of its Brief in Opposition, Pioneer argues that the Court in *Diamond v. Chakrabarty*, 447 U.S. 303 (1980), "directly addresses the question in this case." *Chakrabarty* in fact distinguished the question in this case from the Court's holding. The Court did so when it said one way Congress could signal its intent to exclude a particular type of living thing from the coverage of § 101 was "to craft a statute specifically designed for such living things." 447 U.S. at 318. This instruction by the Court clearly appears to be in recognition of Judge Rich's statement in *Application of Bergy and Application of Chakrabarty*, 596 F.2d 952, 987, n.25 (U.S. Ct. Cust. & Pat. App. 1979), *aff'd*, *Diamond v. Chakrabarty*, 447 U.S. 303 (1980), that "Congress did not intend the term 'manufacture' in § 101 to include plants, which were specifically provided for elsewhere."

Pioneer states at page 11 of its Brief in Opposition that *Mazer v. Stein*, 347 U.S. 201, 217 (1954), held "that patentability of a manufactured article does not bar copyright as a work of art . . ." (The statuettes/lamp stands were not patented.) The Court in *Mazer*, however, based its conclusion on its view that a copyright and a patent do not protect the same attribute of an item. *Id.* Further, the Copyright Act itself provides that the design of a useful article can obtain protection under the Act only if the design features "can be identified separately from and are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101.

CONCLUSION

The petition for writ of certiorari should be granted.

Respectfully submitted,

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